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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/973,056	10/10/2001	Michihiro Izumi	35.C15861	5038

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NEW YORK, NY 10112

EXAMINER

ENG, GEORGE

ART UNIT	PAPER NUMBER
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2643

DATE MAILED: 02/11/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

09/973,056

Applicant(s)

IZUMI ET AL.

Examiner

George Eng

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 17 November 2003.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-21 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-21 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 17 November 2003 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

## **DETAILED ACTION**

### ***Response to Amendment***

1. This office action is in response to the amendment filed 11/17/2003 (paper no. 8).

### ***Drawings***

2. The proposed corrected drawings were received on 11/17/2003 (paper no. 8). These drawings are acceptable.

### ***Claim Rejections - 35 USC § 103***

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

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4. Claims 1, 5-8, 12-15 and 19-21 are rejected under 35 U.S.C. 103(a) as being unpatentable over Yasumoto et al. (JP 10042068 A hereinafter Yasumoto) in view of Idehara (US PAT. 6,438,605).

Regarding claim 1, Yasumoto discloses a communication terminal equipment as shown in figure 1 including means for connection to a public communication line (11), a scanner (2) for reading an image, means for converting the image read by the scanner to have a predetermined format (22, figure 2), means for executing a sending process (24, figure 2) to send to a server connected to the public communication line in a case when the communication terminal equipment sends the converted image as an electronic mail to the Internet comprising means for registering a facsimile number of a destination and an electronic mail address of a destination to an abbreviation dial key, i.e., one easy step key, means for executing the facsimile sending of the read image to the registered facsimile number when the facsimile communication is judged, and means for executing the electronic mail sending of the read image to the registered electronic mail address when the electronic mail communication is judged (abstract). Yasumoto differs from the claimed invention in not specifically teaching a key representing the facsimile sending is depressed pursuant to depression of said abbreviation dial key for executing facsimile sending and a key representing the electronic mail sending is depressed pursuant to depression of said abbreviation dial key for executing electronic mail sending. However, Idehara teaches communication equipment including operating mode selection buttons, i.e., a key representing the facsimile sending (31a, figure 2) and a key representing the electronic mail (31e, figure 2), on an operation panel for selecting between e-mail mode and a facsimile mode col. 4 line 3 through col. 5 line 4 and col. 10 lines 17-19) in order to make user friendly. Therefore, it would have

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been obvious to a person of ordinary skill in the art at the time the invention was made to modify Yasumoto in having the key representing the facsimile sending is depressed pursuant to depression of said abbreviation dial key for executing facsimile sending and the key representing the electronic mail sending is depressed pursuant to depression of said abbreviation dial key for executing electronic mail sending, as per teaching of Idehara, it makes user friendly for selecting between the facsimile mode and the e-mail mode.

Regarding claim 5, Idehara teaches means for registering input data as the electronic mail address in a case where said key representing the electronic mail sending is depressed pursuant to input of the electronic address and means for registering input data as the facsimile number in a case where said key representing the facsimile sending is depressed pursuant to input of the facsimile data in the registering process for the abbreviation number (col. 4 line 3 through col. 5 line 4 and col. 10 lines 17-19).

Regarding claim 6, Idehara teaches means for registering input data as the electronic mail address in a case where a specific symbol, i.e., @, used in the electronic mail address is included in the input data in the registering process for the abbreviation number (col. 4 lines 3-32 and col. 10 lines 17-19).

Regarding claim 7, Idehara discloses the communication equipment including a first CPU (11, figure 1) for detecting that said key representing the electronic mail sending is depressed, means for notifying a second CPU (18, figure 1) that the first CPU executed the detection, means for forming electronic mail data when the second CPU receives the notification and means for executing the data sending process from said second CPU to the public communication line (col. 3 lines 49-57 and col. 5 lines 9-48).

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Regarding claim 8, the limitations of the claim are rejected as the same reasons set forth in claim 1.

Regarding claim 12, the limitations of the claim are rejected as the same reasons set forth in claim 5.

Regarding claim 13, the limitations of the claim are rejected as the same reasons set forth in claim 6.

Regarding claim 14, the limitations of the claim are rejected as the same reasons set forth in claim 7.

Regarding claim 15, the limitations of the claim are rejected as the same reasons set forth in claim 1.

Regarding claim 19, the limitations of the claim are rejected as the same reasons set forth in claim 5.

Regarding claim 20, the limitations of the claim are rejected as the same reasons set forth in claim 6.

Regarding claim 21, the limitations of the claim are rejected as the same reasons set forth in claim 7.

5. Claims 2, 9 and 16 are rejected under 35 U.S.C. 103(a) as being unpatentable over Yasumoto et al. (JP 10042068 A hereinafter Yasumoto) in view of Idehara (US PAT. 6,438,605) as applied in claims above, and further in view of Ishibashi et al. (EP 812100 A2 hereinafter Ishibashi).

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Regarding claim 2, the combination of Yasumoto and Idehara differs from the claimed invention in not specifically teaching means for notifying the destination by using the facsimile number registered for the abbreviation number of sending a notification in electronic mail format within a predetermined time before or after the sending of the electronic mail in a case in which the electronic mail is sent to the electronic mail address. However, Ishibashi teaches a communication terminal apparatus capable of informing a receiving side of with a transmission of an electronic mail in case of sending the electronic mail to the electronic mail address (page 2 lines 42-59 and page 4 line 40 through page 6 line 29) in order to quickly notify the receiving side that electronic mail has been transmitted. Therefore, it would have been obvious to a person of ordinary skill in the art at the time the invention was made to modify the combination of Yasumoto and Idehara in notifying the destination by using the facsimile number registered for the abbreviation number of sending a notification in electronic mail format within a predetermined time before or after the sending of the electronic mail in a case in which the electronic mail is sent to the electronic mail address, as per teaching of ishibashi, in order to quickly notify the receiving side that electronic mail has been transmitted.

Regarding claim 9, the limitations of the claim are rejected as the same reasons set forth in claim 2.

Regarding claim 16, the limitations of the claim are rejected as the same reasons set forth in claim 2.

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6. Claims 3-4, 10-11 and 17-18 are rejected under 35 U.S.C. 103(a) as being unpatentable over Yasumoto et al. (JP 10042068 A hereinafter Yasumoto) in view of Idehara (US PAT. 6,438,605) as applied in claims above, and further in view of Yazaki (JP 10126600 A).

Regarding claim 3, Yasumoto discloses the communication terminal equipment for executing the facsimile sending of the read image to the registered facsimile number by using a first communication channel (L2, figure 1) and executes the electronic mail sending of the read image to the registered electronic mail address by using a second communication channel (L1) by depression of the key corresponding to the abbreviation number (abstract) and Idehara teaches to depress said key representing the facsimile sending and said key representing the electronic mail sending for executing facsimile sending and electronic mail sending col. 4 line 3 through col. 5 line 4 and col. 10 lines 17-19). The combination of Yasumoto and Idehara differs from the claimed invention in not specifically teaching to simultaneously executing plural communications. However, Yazaki teaches a communication terminal equipment to allow an adapted data transmission means to send data by registering a logic address of a transmission destination and a data transmission means in cross reference so that the data transmission means corresponding to the selected logic address sends data to each destination when an operation section select the logic address of the destination, thereby data can be sent automatically to each physical address (abstract). Therefore, it would have been obvious to a person of ordinary skill in the art at the time the invention was made to modify the combination of Yasumoto and Idehara in simultaneously executing plural communications, as per teaching of Yazaki, thereby data can be sent automatically to each physical address.



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Regarding claim 4, although neither the combination of Yasumoto and Idehara nor Yazaki specifically discloses a key representing simultaneously sending of the facsimile and the electronic mail, it is well known in the art of combining said key representing the facsimile sending and said key representing the electronic mail sending as one key for simplifying operation structure so that plural communications, i.e., facsimile sending and electronic mail sending, can be simultaneous performed when a key representing simultaneously sending of the facsimile and the electronic mail is depressed. Therefore, it would have been obvious to a person of ordinary skill in the art at the time the invention was made to modify Yasumoto, Idehara and Yazaki in having the key representing simultaneously sending of the facsimile and the electronic mail in order to simplify operation structure.

Regarding claim 10, the limitations of the claim are rejected as the same reasons set forth in claim 3.

Regarding claim 11, the limitations of the claim are rejected as the same reasons set forth in claim 4.

Regarding claim 17, the limitations of the claim are rejected as the same reasons set forth in claim 3.

Regarding claim 18, the limitations of the claim are rejected as the same reasons set forth in claim 4.

### ***Response to Arguments***

7. Applicant's arguments filed 11/17/2003 (paper no. 8) have been fully considered but they are not persuasive.

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In response to applicant's argument that neither Yasumoto nor Idehara teaches both a telephone number and an E-mail address can be register in one abbreviation number, it appears that Yasumoto clearly teaches to register a telephone number and an electronic mail address to an abbreviation dial or a one easy step key in a coexisting state (abstract) so that it would have a single abbreviate number to which a telephone number and an e-mail address are both registered. As a result, independent claims 1, 8 and 15 are still rejected under the combination of Yasumoto and Idehara. The other claims in the application are each dependent from one or another of the independent claims discussed above and are rejected for the same reasons.

### ***Conclusion***

8. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

9. Any response to this final action should be mailed to:

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Commissioner of Patents and Trademarks

Washington D.C. 20231

Or faxed to:

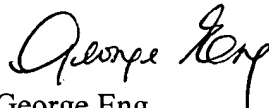
(703) 872-9314 (for Technology Center 2600 only)

Hand delivered responses should be brought to Crystal Park II, 2121 Crystal Drive,  
Arlington, V.A., Sixth Floor (Receptionist).

10. Any inquiry concerning this communication or earlier communications from the examiner should be directed to George Eng whose telephone number is 703-308-9555. The examiner can normally be reached on Tuesday to Friday from 7:30 AM to 6:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Curtis A. Kuntz, can be reached on (703) 305-4870. The fax phone number for the organization where this application or proceeding is assigned is 703-308-6306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 306-0377.

  
George Eng  
Primary Examiner  
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